

REMARKS

Claims 1-20 were pending in this application. All claims were rejected. No claims have been amended or cancelled. Reconsideration of the rejections of all pending claims is requested.

I. **Rejection of Claims 1-5 and 7-10 Under 35 U.S.C. §102(e)**

Claims 1-5 and 7-10 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0117499A1 to Bianchi et al.

In summary, the applicants contend that the rejection under 35 U.S.C. §102(e) is not proper because the present application and the cited publication were both invented by the same inventors. Thus, the cited publication was not "by another" per 35 U.S.C. §102(e).

35 U.S.C. §102(e) states:

(e) the invention was described in — (1) an application for patent, published under section 122(b), **by another** filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

The cited reference is a publication, but it is not "by another" per 35 U.S.C. §102(e). Both inventors of the present application are the same two inventors of the published application. Thus, the rejection under 35 U.S.C. §102(e) is not proper.

Based on the foregoing, the applicants respectfully request reconsideration of the rejection.

II. Rejection of Claims 6 and 11-20 Under 35 U.S.C. §103(c)

Claims 6 and 11-20 were rejected under 35 U.S.C. §103(c) as being anticipated by U.S. Publication No. 2003/0117499A1 to Bianchi et al in view of U.S. Patent No. 6,615,293 to Shima et al.

The applicants note that the Bianchi reference cited in the rejection under 35 U.S.C. §102(e) is the same as the reference cited in this rejection. The applicants also note that 35 U.S.C. §103(c) is not a ground of rejection, but rather an exemption to 35 U.S.C. §103(a). The applicants will continue as though the rejection is based on 35 U.S.C. §103(a).

In summary, the applicants contend that 35 U.S.C. §103 is not applicable because the present application and the cited reference were owned or subject to an obligation of assignment to the same person at the time the invention was made.

MPEP 706.02(I)(1) sets forth rules for 35 U.S.C. §103. MPEP 706.02(I)(1) is restated as follows:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999.

This application was filed January 2, 2002, thus falling under the rules of MPEP 706.02(I)(1). This application and reference (Bianchi et al.) were, at the time the

invention was made, owned by the same person or subject to an obligation of assignment to the same person.

MPEP §706.02(I)(3) provides instructions related to common ownership and the like in view of 35 U.S.C. 103 rejections. MPEP §706.02(I)(3) is restated as follows::

Applications and patents will be considered to be owned by, or subject to an obligation of assignment to, the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person(s) or organization(s).

Per MPEP §706.02(I)(3), the attorney of record hereby states that at the time the invention was made, the application and reference (Blanchi et al.) were owned by, subject to an obligation of assignment to, the same organization.

Based on the foregoing, the applicants respectfully request reconsideration of the rejection.

In view of the above, all of the pending claims are now believed to be in condition for allowance and a notice to that effect is earnestly solicited.

Respectfully submitted,
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